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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,940	12/15/2003	John H. Kiekhaefer	6499-6	3705
44190	7590	01/18/2005	EXAMINER	
WALTER W. DUFT LAW OFFICES OF WALTER W. DUFT 8616 MAIN ST SUITE 2 WILLIAMSVILLE, NY 14221			FUREMAN, JARED	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

**Office Action Summary**

Application No.

10/735,940

Applicant(s)

KIEKHAEFER, JOHN H.

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,9-11,15,16,24-26,30-32,34,37,38 and 91-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 9-11, 15, 16, 24-26, 30-32, 34, 37, 38, and 91-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Receipt is acknowledged of the amendment, on 10/28/2004, which has been entered in the file. Claims 1, 9-11, 15, 16, 24-26, 30-32, 34, 37, 38, and 91-95 are pending.

#### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 9-11, 15, 16, 24-26, 30-32, 34, 37, 92 and 93 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 17, of U.S. Patent No. 6,732,936 (hereinafter the '936 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 9-11, 15, 16, 24-26, 30-32, 34, 37, 92 and 93, of the instant application, are somewhat broader versions of claims 1-10 and 17, of the '936 patent.

For example, claim 1 of the '936 patent recites: a financial transaction card that is transparent or translucent to human viewing yet detectable by automated card

processing equipment having near Infrared source/detector pairs each having a source and a detector respectively positioned to face opposing sides of said card when said card is positioned in said equipment for detection and to detect said card by sensing an interruption of near Infrared light transmitted from said source to said detector due to the presence of said card, comprising: a substantially planar material sheet having upper and lower surfaces bounded by a continuous peripheral edge; said material sheet being transparent or translucent to human viewing; and a near Infrared light filter covering one of said upper or lower surfaces of said material sheet, said filter comprising light absorbing dye filtering means for providing sufficient card opacity relative to one or more near Infrared light wavelengths to render said card detectable by said source/detector pairs by blocking near Infrared light emitted by said source from reaching said detector, thereby triggering detection of said card, while still allowing said card to remain transparent or translucent to visible light.

3. Claims 1 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 11, respectively, of U.S. Patent No. 6,705,530 (hereinafter the '530 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 16 of the instant application, are somewhat broader versions of claims 1 and 11 of the '530 patent.

For example, claim 1 of the '530 patent recites: a financial transaction card that is transparent or translucent to human viewing yet detectable by automated card processing equipment having near Infrared source/detector pairs, each source/detector

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pair including a near Infrared light source and a near Infrared light detector respectively positioned to face opposing sides of said card when said card is positioned in said equipment for detection and to detect said card by sensing an interruption of near Infrared light transmitted from said source to said detector due to the presence of said card, comprising: a substantially planar material sheet having upper and lower surfaces bounded by a continuous peripheral edge; said material sheet having an area that is at least minimally transparent or translucent to human viewing and located so as to span an optical pathway of one or more of said source/detector pairs when said card is positioned in said equipment for detection; and an Infrared light filter associated with said area, said filter providing sufficient opacity to near Infrared light to render said card detectable by said source/detector pairs and being arranged to block the optical pathways of all source/detector pairs spanned by said area, thereby triggering detection of said card, while still allowing said card to remain transparent or translucent to visible light in said area.

4. Claims 1, 9, 16, 24, 25, 31, 32, 34, 37, and 92-95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 9, 16, 9, and 24, respectively, of U.S. Patent No. 6,296,188 (hereinafter the '188 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 9, 16, 24, 25, 31, 32, 34, 37, and 92-95, of the instant application, are somewhat broader versions of claims 1, 8, 9, 16, 9, and 24 of the '188 patent.

For example, claim 1 of the '188 patent recites: a financial transaction card that is transparent or translucent to human viewing yet detectable by automated card processing equipment having near Infrared source/detector pairs each having a source and a detector respectively positioned to face opposing sides of said card when said card is positioned in said equipment for detection and to detect said card by sensing an interruption of near Infrared light transmitted from said source to said detector due to the presence of said card, comprising: a substantially planar material sheet having upper and lower surfaces bounded by a continuous peripheral edge; said material sheet being transparent or translucent with respect to human visible light; and a near Infrared light filter covering one of said upper or lower surfaces of said material sheet, said filter comprising a screen-printed coating of a light filtering powder dissolved in a clear liquid carrier at a powder-to-carrier ratio of about 0.2-5% by weight; said filter producing sufficient card opacity relative to one or more near Infrared light wavelengths to render said card detectable by said source/detector pairs by blocking near Infrared light emitted by said source from reaching said detector, thereby triggering detection of said card, while still allowing said card to transmit human visible light.

5. Claims 1, 10, 11, 15, 16, 26 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 1, 7, 10, 11, 17 and 20, respectively, of U.S. Patent No. 6,290,137 (hereinafter the '137 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 10, 11, 15, 16, 26 and 30, of the instant application, are somewhat broader versions of claims 1, 1, 7, 10, 11, 17 and 20 of the '137 patent.

For example, claim 1 of the '137 patent recites: A financial transaction card that is transparent to human viewing yet detectable by automated card processing equipment having near Infrared source/detector pairs each having a source and a detector respectively positioned to face opposing sides of said card when said card is positioned in said equipment for detection and to detect said card by sensing an interruption of near Infrared light transmitted from said source to said detector due to the presence of said card, comprising: a substantially planar material sheet having upper and lower surfaces bounded by a continuous peripheral edge; said material sheet being transparent to human viewing; and a near Infrared light filter covering one of said upper or lower surfaces of said material sheet, said filter comprising filtering means for producing sufficient card opacity relative to one or more near Infrared light wavelengths to render said card detectable by said source/detector pairs by blocking near Infrared light emitted by said source from reaching said detector, thereby triggering detection of said card, while still allowing said card to remain transparent to visible light such that definable images can be viewed through said card.

***Allowable Subject Matter***

6. Claims 1, 9-11, 15, 16, 24-26, 30-32, 34, 37, 38, and 91-95 would be allowable upon the filing of a terminal disclaimer.

Applicant's arguments, see page 7 of the amendment, filed 10/28/2004, with respect to Bratchley failing to teach the filter comprising a dye and a colorant have been fully considered and are persuasive. The rejection of claim 31 (and claims dependent thereon) has been withdrawn.

Also see pages 10-11 of the office action, mailed on 4/23/2004, and the arguments and affidavit, filed on 10/16/2003 in the parent application (10/339,814), regarding the priority date of the Lasch et al references.

Kobayashi et al (US 5,614,289) teaches that a colorant used in an ultraviolet-setting protective layer may be an infrared absorbing dye (see column 29, lines 19-27). However, given the different application and use of the infrared absorbing dye, as taught by Kobayashi et al, without the benefit of applicant's teachings, there is no motivation for one of ordinary skill in the art at the time of the invention to combine the teaching of Kobayashi et al with the prior art of record in a manner so as to create the claimed invention.

### ***Conclusion***

7. The art made of record and not relied upon is considered pertinent to applicant's disclosure. Lasch et al (US 6,764,014) and Lasch et al (US 6,749,123) both teach a transparent/translucent financial transaction card including an infrared light filter.

Kobayashi et al (US 5,614,289) teaches that a colorant used in an ultraviolet-setting protective layer may be an infrared absorbing dye (see column 29, lines 19-27).

Ishida (JP 8-169192 A) teaches an information recording card including an infrared beam absorptive layer applied to the card by applying ink containing carbon black (see the attached translation of the abstract and constitution).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

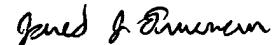
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jared J. Fureman  
Examiner  
Art Unit 2876

January 13, 2005